

HEIDL RIEDEL ET AL.
USSN 10/016,964
REPLY TO OFFICE ACTION DATED JANUARY 12, 2005
AMENDMENT DATED JULY 12, 2005

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Mostly editorial changes are made to claims 1 and 16. Also, new claim 17 is added which is a combination of claims 1 and 10. It is not believed that the editorial changes to claims 1 and 16, or the introduction of new claim 17 raises any issues of new matter.

In claims 1 and 16, Applicants have also specified that component I is an emulsion that comprises the emulsifier system A-B-C. Support for this concept can be found throughout the

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entire disclosure, and particularly the examples, which show an emulsion composition, which is expanded by a gas. Applicants do not believe these changes introduce new matter. An early notice to that effect is earnestly solicited.

Further on this point, in the Response to Arguments section on page 5 of the Office Action dated November 4, 2003, the Examiner commented that the percentage weights on which Applicants relied were not the composition as a whole, but the composition without nitrogen. Belatedly, Applicants point out that the gas adds very little to the weight of the composition, as would be understood by persons skilled in the art, and the percentage weights in the instant specification and in the Bellon reference can also be taken as those of the emulsion. This is consistent with the instant examples, wherein the weight percentages are given for the components of the emulsion itself, without taking into account the subsequent addition of the gas.

Turning to the substantive issues, claims 1-6, 11, 13, 15 and 16 were rejected under 35 USC § 103(a) as being obvious over Bellon, FR 2789397.

Claims 8-10 were rejected under 35 USC §103(a) as being obvious over Bellon in view of Synder, US 4,708,813.

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Claim 12 was rejected under 35 USC § 103(a) as being obvious over Bellon in view of Saint-Leger et al. ("Saint-Leger"), US 5,939,077.

In response to *all three* obviousness rejections, Applicants submit that the difference between the instant claims is not obvious. Although the Examiner's continued reliance on *In re Aller*, 105 USPQ 233 (CCPA 1955) is noted, that case pertained to *process* claims, which are not here involved, and, moreover, addressed the optimization of known result-effective variables. *See, e.g., In re Antoine*, 195 USPQ 6 (CCPA 1977), for the proposition does not apply where the prior art does not reveal the optimized variable to be result-effective. The prior art does not reveal the choice and quantity of emulsifiers to be a result-effective variable effecting long-term stability of the preparation. Indeed, as previously noted, Bellon says very little about the importance of the emulsifier. Therefore, Applicants again submit that, as a matter of law, Bellon cannot render the present claims *prima facie* obvious.

Further on this point, Applicants note that the specification teaches at page 2, lines 15-23, that the known foams have only low stability, wherein they usually collapse within approximately 24 hours. Cosmetic compositions, however, should be stable for as long as possible, preferably years. The prior art has solved this problem by, for example, by preparing the foam at the time the consumer intends to use it by providing packages that mix the base and a propellant at the time of use, thereby producing the foam.

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As taught in the specification at page 2, lines 30 ff, the prior art does not include any sort of cosmetic or dermatological preparations that are foamed when first prepared, yet which can be packaged, stored and marketed. It is further taught in the very next paragraph, which appears at the top of page 3, that the present invention had the object of providing preparations that do not suffer these disadvantages. It is further thought on page 4, lines 12-18, that the inventive preparations are extraordinarily stable, even in cases of an unusually high gas volume.

Bellon does not teach or suggest anywhere that emulsifier choice and quantity are result-effective variables affecting long-term stability of the type involved here. In fact, as noted above, Bellon teaches little, if anything, about the importance of the emulsifier in any respect. Consequently, a person having ordinary skill in the art would not, in fact, have been motivated to optimize the emulsifier amounts required according to the present claims. Therefore, Bellon does not make out a *prima facie* case of obviousness.

The Examiner says the record contains no clear and convincing evidence of nonobviousness or unexpected results. However, Applicants submit that this puts the cart before the horse. Before Applicants can be expected to submit proof of unexpected results, the Examiner must make out a *prima facie* case of obviousness. Before the Examiner can make out a *prima facie* case of obviousness, the Examiner must show that Bellon teaches or suggests the

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emulsifier choice and quantity are result-effective variables affecting long-term stability or some other practical parameter. If they were taught or suggested by Bellon to be result effective variables, persons skilled in the art would have had no reason to optimize them.

Even if persons skilled in the art would have had motivation to optimize them, Bellon teaches optimization lies away from the instant invention. Based on Bellon's teachings at pages 3-4, as best Applicants can make out, the amounts of PEG-100 stearate glyceryl stearate, stearic acid and octyldecanol in Bellon's Example 1 appear to be minimums. Accordingly, persons skilled in the art, following Bellon's teachings would have been motivated to add more of these components, not less. Yet, as previously pointed out, Bellon's amounts of these three components already add up to 40% by weight of the emulsion, whereas the instant claims require a maximum of 20%—exactly $\frac{1}{2}$ of Bellon's medium. Bellon's teachings of higher amounts being preferred would actually have motivated persons skilled in the art away from the present invention, not towards it. Consequently, such persons would not, in fact, have been motivated to manipulate the amounts to fall within the present claims.

New claim 16 requires that the foam be packaged, which, as discussed above, finds support in the specification as filed. Bellon's mousse is intended to be formed by the consumer at the time of use. Therefore, Bellon does not teach or suggest the prepackaged foams as required by claim 16.

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The Examiner says that placing a known cosmetic composition or preparation in a package is deemed obvious since it is well within the knowledge and conventional skills in the art. However, Applicants have explained above why packaging Bellon's mousse would not have been obvious to persons skilled in the art, i.e., Bellon's mousse is intended to be formed by the consumer *at the time of use*, and, therefore, persons skilled in the art would have had no practical reason to package Bellon's mousse.

Moreover, as reemphasized by the Court of Appeals for the Federal Circuit most recently in *In re Lee*, 61 USPQ2d 1430 (CA FC 2002), all findings necessary to establish a *prima facie* case of obviousness must be based on objective evidence; it is improper for the patent examiner to generalize that certain claim limitations would have been obvious or could have been found. As stated by the Court:

"The Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability. 'Common knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See *Allentown Mack*, 522 U.S. at 376 ('Because reasoned decision-making demands it, and because the systemic consequences of any other approach are unacceptable, the Board

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must be required to apply in fact the clearly understood legal standards that it enunciates in principle’”

Id. at 1435.

Consequently, with respect to claim 16, the Examiner cannot simply conclude that the difference between it and Bellon’s disclosure “is deemed obvious.” The Examiner must make findings supported by objective evidence on the issue, and the Examiner must consider Applicants’ argument that Bellon’s intended formation of the mousse at the time of use by the end user would have negated any suggestion that persons skilled in the art would have been motivated to package it.

The secondary references are of no help in bridging the gap between Bellon and the instant claims. Synder is relied upon only to teach the additional features of dependent claims 8-10, and Saint-Leger is relied upon only to teach the use of carbon dioxide as an expansion gas. Consequently, the combination of Bellon and these secondary references still fails to render obvious the basic features of the present invention.

In view of the foregoing, Applicants respectfully submit that the Examiner would be fully justified to reconsider and withdraw all of the prior art rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

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For completeness, new claim 17 requires that no more than 5% by weight of any other emulsifiers should be present in the emulsion. This claim is, thus, further removed from Bellon alone or in combination with the other cited references, particularly since Bellon prefers significantly higher amounts of A-B-C.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

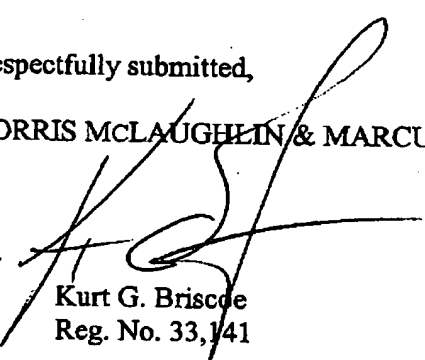
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


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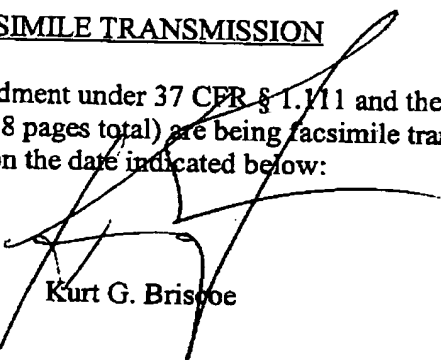
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the accompanying Petition for Extension of Time (18 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: July 12, 2005

By:


Kurt G. Briscoe